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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,171	11/09/1999	JOHN M. KRAJNIK	5661	7614

7590 12/03/2001

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 12/03/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/437,171

Applicant(s)

KRAJNIK ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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**DETAILED ACTION**

**Information Disclosure Statement**

1. **The information disclosure statement filed 09/25/01 has been considered and placed in the application file.**

**Claim Rejections - 35 USC § 103**

2. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

3. **The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:**

1. **Determining the scope and contents of the prior art.**
2. **Ascertaining the differences between the prior art and the claims at issue.**
3. **Resolving the level of ordinary skill in the pertinent art.**
4. **Considering objective evidence present in the application indicating obviousness or nonobviousness.**

4. **Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Cruden et al*(U.S. 4,176,103) in combination with *Huth et al*(U.S. 5,102,936).**

***Cruden et al* disclose and exemplify modified polymer latexes, useful in coating and binder compositions, wherein said polymer is derived from**

*carbonyl-containing monomers such as vinyl acetoacetate, diacetone acrylamide, etc. and other monoethylenically unsaturated monomers which include fatty acid vinyl esters, esters of (meth)acrylic acid such as butyl acrylate, unsaturated carboxylic acids which include (meth)acrylic acid, etc. More specifically, Cruden et al exemplifies diacetone acrylamide-governed polymer latexes derived from 44 wt.% of methyl methacrylate, 50 wt.% of butyl acrylate, 2 wt.% of methacrylic acid and 4 wt.% of diacetone acrylamide and clearly overlapping in scope with component (a) per claim 1. See, e.g., the Abstract, cols. 1-6 and the Runs, especially Run 2 of Cruden et al.*

*Huth et al teach aqueous copolymer dispersions, useful as rheology-modifying thickener substances in aqueous systems, wherein said copolymers are derived from ethylenically unsaturated monomers which comprise 0.1 to 30 wt.% of macromonomer units of surface-active urethane derivatives, 0-5 wt.% of carbonyl-group containing compounds, etc., said copolymer comfortably overlapping in scope with component (b) per claim 1. See, e.g., the Abstract, cols. 2-10 and the Runs of Huth et al. The disclosure of Cruden et al differs basically from the claimed invention as per the non-express disclosure of an embodiment directed to the precisely defined second polymer (b) per the claimed invention.*

*However, Cruden et al at col. 6, lines 1-6 teaches that the coating compositions derived from these modified polymer latexes can include materials such as thickeners, etc. To this end, one having ordinary skill in the art would have found it obvious, on its face, to use the copolymer*

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*of Huth et al, as the thickener in the aqueous system of Cruden et al and with a reasonable expectation of obtaining the cumulative additive effect. Criticality for such, clearly commensurate in scope with the claims, not having been demonstrated on this record.*

**Response to Arguments**

**5. Applicant's arguments with respect to claim 1-17 have been considered but are moot in view of the new ground(s) of rejection.**

**Conclusion**

**6. After further consideration coupled with the claim amendments + Counsel's persuasive arguments, the rejections based on the prior art per paragraphs 4, 5, 7 and 8 in the previous Office Action of paper no. 3, 04/25/01 are herein withdrawn and no further comment is deemed necessary.**

**Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..**

**If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.**

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***Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.***

*J. M. Reddick*  
**Judy M. Reddick**  
**Primary Examiner**  
**Art Unit 1713**

*JMR Jmr*  
**November 29, 2001**